

REMARKS

I. Status of Claims

Claims 1-69 are pending in this application. Claims 4-17, 19-24, 26, 27, 29-34, 40-42, and 59-69 were withdrawn from consideration as directed to non-elected invention/species. No amendments are made in this Reply.

II. Claim Rejections under 35 U.S.C. § 103

A. Sweger in view of Matsumoto and Uchiyama

The Office maintained and finalized the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,482,704 to Sweger et al. ("Sweger") in view of U.S. Patent No. 6,010,689 to Matsumoto et al. ("Matsumoto") and U.S. Patent No. 5,876,705 to Uchiyama et al. ("Uchiyama"). Office Action dated August 11, 2004, at page 2.

In response to Applicants' argument that the combination of cited references cannot be relied upon simply because the references disclose what is "normally used," the Office continues to assert there is a motivation to combine because hair conditioners and surfactants are well-known essential ingredients and are known to be used in hair compositions similar to those claimed. *Id.* at page 5. In the Advisory Action, the Office also relies on *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (C.C.P.A. 1981), to support the assertion that "one cannot show obviousness by attacking references individually where the rejections are based on combinations of references." Advisory Action mailed December 7, 2004. Applicants continue to assert that these broad conclusory statements regarding the teachings of multiple references alone are

not sufficient to amount to actual evidence that is "clear and particular" under an obviousness inquiry given the combination of references cited herein. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999). As such, Applicants respectfully disagree for the reasons of record and for the following additional reasons.

The Office relies on Sweger's teachings of amino-multicarboxylate modified starch. Office Action at page 2. Because Sweger does not teach conditioning agents or anionic surfactants, the Office relies on Matsumoto and Uchiyama to remedy these deficiencies. *Id.* at page 3. In particular, Matsumoto is relied upon for teaching behenyltrimethylammonium (conditioning agent) and alkyl ether sulfate (anionic surfactant). *Id.* The Office relies upon Uchiyama to teach "a conditioning shampoo compositions may comprise anionic surfactants, conditioning agent, . . . and thickener." *Id.* Irrespective of whether this is a true reading of Matsumoto or Uchiyama, the Examiner is picking and choosing from various references in an attempt to achieve the claimed invention. However, "[i]t is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

For instance, the primary reference (Sweger) admittedly fails to teach conditioning agents or anionic surfactants. Office Action dated August 11, 2004, at page 2. As argued through out the prosecution, the Office fails to provide, among other

things, a suggestion or motivation to combine Sweger with Matsumoto and Uchiyama.

See M.P.E.P. § 2143 (8th ed. Rev. 2, 2004).

Matsumoto is directed to hair treatment compositions containing particular types of functional silicone that generates certain conditioning benefits. Matsumoto at Col. 1, ll. 26-30. Specifically, Matsumoto directs one to the addition of the recited amidopolyether functional silicone of general formula (I). *Id.* at Col. 1, ll. 5-8, 35-54; Abstract. The Office, however, does not rely on Matsumoto for this teaching but instead, for behenyltrimethylammonium as a conditioning agent and alkyl ether sulfate as anionic surfactants. See Office Action dated August 11, 2004, at page 3. Nothing in Matsumoto, however, directs a skilled artisan to these particular ingredients. Under the Office's rationale, a skilled artisan ignores the teaching in Matsumoto to the various novel types of functional silicones and instead, relies on teachings buried within the specification that require picking and choosing based on Applicants' specification *not* on the direction of the cited prior art. Although Matsumoto is drawn to "cosmetic" compositions, neither Matsumoto nor Sweger provide the "clear and particular" evidence supporting the combination of references required under a Section 103 inquiry and as such, lead the skilled artisan to the presently claimed composition. *Dembicazk*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617.

Likewise with respect to Uchiyama, this patent is directed to conditioning shampoo compositions comprising a deterative surfactant, a fatty compound, a hair conditioning agent, and water. Uchiyama at Col. 1, ll. 8-13. There, however, is nothing in Uchiyama nor does the Office direct Applicants to a teaching or suggestion therein leading a skilled artisan to the disclosure of the relied upon ingredients, i.e., the

conditioning agents such as behenyltrimethylammonium, surfactants and thickeners. Office Action dated August 11, 2004, at page 3. Instead, Uchiyama like Matsumoto teaches a whole range of varying types of cosmetic ingredients equally available for inclusion in the present composition based on the Office's rationale but Uchiyama lacks a suggestion or teaching particularly leading the skilled artisan to the relied upon ingredients for inclusion with Sweger. As such, the Office has failed to show "reasons that the skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 146 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

For at least these reasons, the Office fails to establish a prima facie case of obviousness and thus, Applicants respectfully request the withdrawal of this rejection.

**B. Janchipraponvej in view of Sweger and Martino
and in further view of Uchiyama**

Further, the Office maintained and finalized the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,954,335 to Janchipraponvej ("Janchipraponvej") in view of Sweger and U.S. Patent No. 6,210,689 to Martino et al. ("Martino") and in further view of Uchiyama. Office Action at page 3. In response to Applicants' arguments, the Office maintains that the motivation to combine the cited references is in the references themselves and in the knowledge generally available to one of ordinary skill in the art. *Id.* at page 7.

Furthermore, in the Advisory Action, the Office reiterates, "the motivation to combine is clear, i.e., to benefit from the improved results of the amphoteric starch with respect to

viscosity and thickening,” which the Office points out is disclosed by Sweger and is not a conclusion by the Office. Advisory Action dated December 7, 2004. Applicants respectfully disagree for the reasons of record and for the following additional reasons.

Applicants continue to assert that the mere identification of the teachings in each reference does not itself preclude patentability. See *Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1458. The Office asserts that it was obvious to modify Janchipraponvej’s composition with the amphoteric starches of Sweger and anionic surfactants of Martino “to benefit from the improved results of the amphoteric starches with regard to viscosity and thickening as taught by Sweger.” Office Action at page 4, line 21-page 5, line 3; see also, Advisory Action dated December 7, 2004.

The disclosure of Sweger, however, does not remedy the deficiencies in Janchipraponvej. Sweger is directed to “cosmetic compositions which contain amino-multicarboxylate starch derivatives.” Sweger at Col. 1, ll. 34-35. Nowhere in Sweger is there any teaching or suggestion that its disclosed, modified starch compositions would be desirable additives to the compositions of Janchipraponvej, i.e., quaternary ammonium compounds. Indeed, nothing but Applicants’ disclosure provides such a suggestion.

Moreover, the Office asserts that Applicants’ argue against the references individually but that one cannot show nonobviousness by attacking references individually where rejections are based on a combination of references. Office Action at page 7, lines 12-15. Applicants disagree for at least the reason that the primary reference, Janchipraponvej, teaches away from Martino’s disclosure. See Reply filed May 21, 2004 at pages 6, 8-10; see also, M.P.E.P. § 2145. The Federal Circuit has

repeatedly recognized that proceeding contrary to accepted wisdom in the art presents "strong evidence of unobviousness." *In re Hodges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983). For this reason alone, the rejection is improper and should be removed.

Furthermore, in the same manner as discussed above with regard to the Section 103 rejection of Sweger in view of Matsumoto and Uchiyama, the cited references combined in this rejection fail to teach or suggest the presently claimed invention. For instance, Janchipraponvej is directed to a clear conditioning composition comprising a quaternary ammonium compound, a solubilizing nonionic surfactant and a polyhydric compound but admittedly, fails to teach modified starch and anionic surfactants. Janchipraponvej at Col. 1, ll. 5-47; see *also*, Office Action dated August 11, 2004, at page 4. As detailed above, Sweger does not remedy the deficiencies in Janchipraponvej especially considering the lack of a suggestion or teaching in Sweger providing for the inclusion of the teaching directed to modified starches with quaternary ammonium compounds of Janchipraponvej. Although the Office continues to assert a motivation based on benefiting from the improved results of the amphoteric starch with respect to viscosity and thickening, this teaching allows for the importation of *any* modified starch amounting to the disclosure of hundreds, if not, thousands of different starches known in the art, but the Office fails to identify what in Sweger would make the skilled artisan look to the teachings therein. In fact, the Federal Circuit opined that piecing together elements of the claimed invention found in various pieces of prior art to defeat patentability is impermissible and instead, requires a suggestion or motivation to

do so. *Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1458. Although Janchipraponvej, Sewger, Martino and Uchiyama may teach individual components of the present invention, this alone is not enough to suggest or motivate one to select from those individual teachings the necessary elements for combination in the manner presently claimed. *Id.*, 47 U.S.P.Q.2d at 1458.

Moreover, without specific teachings in the cited references, directing the skilled artisan to specifically select the modified starch of Sweger and incorporate it into the composition of Janchipraponvej, nothing, other than Applicants' own disclosure, could have led the Office to the conclusion that the particular combination was obvious. Since using hindsight in this way to determine the obviousness of a particularly claimed invention is improper, the rejection under 35 U.S.C. § 103 should be withdrawn.

III. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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